

REMARKS/ARGUMENTS

Status of Application

Claims 1-16 remain in this application. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1, and 3-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,737,539 to Edelson et al. Claims 2 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Edelson et al.

Applicants have amended the specification to provide proper antecedent basis for one or more distribution facilities connected to the system to allow a prescription order to be transmitted thereto. This subject matter was sufficiently specific and detailed in original claim 9 to provide support for the amendment to the description. The specification was also amended to describe a plurality of shipping facilities. This subject matter was sufficiently specific and detailed in original claim 1 to provide support for the amendment to the description.

Applicants have amended independent claim 1 with respect to the transmission of the prescription order so that the language from original claim 1 is now used again. The Examiner's rejection under 35 U.S.C. § 112, first paragraph, is now moot.

Applicants respectfully traverse the rejections and requests reconsideration.

Claims 1-8

It is respectfully submitted that Edelson et al. does not disclose a system that is connected to one or more shipping facilities, and in particular, Edelson et al. does not disclose a system that is capable of enabling each of one or more customers to one of transmit a prescription order to at least one of the plurality of member pharmacies and one of the one or more shipping facilities, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities.

Edelson et al. generally discloses a professional data management system, and in particular, a computer-implemented prescription management system to assist physicians in prescribing and reviewing drugs. The system disclosed in Edelson et al. is directed to

assisting physicians in prescribing and reviewing drugs. Edelson et al. is not directed to distributing or shipping prescription drugs. In particular, it is written in Edelson et al. that its system "makes possible significant improvements in the quality of prescriptions written," by providing physicians access to adequate, reliable drug information for "electronic prescription creation by a prescriber at a point of patient care..." Col. 4, lines 20-28.

After pointing out to the Examiner in the previous Amendments submitted by the applicant that Edelson et al. does not disclose or suggest any type of system connected to a shipping facility, the Examiner argues in the latest Office action that "it is inherent that if a prescription drug is shipped to a customer or a pharmacy, that the drug was shipped from a shipping facility." Office action page 4. This argument fails because Edelson et al. does not disclose shipping a drug to either a customer or a pharmacy. Thus, a shipping facility cannot be inherent. Furthermore, even if it was disclosed that a drug was shipped to a customer, applicants do not concede that it would be inherent that the drug was shipped from one or more shipping facilities that are connected to an intranet server.

As previously mentioned, Edelson et al. is concerned with providing a computer system that gives physicians sufficient information to write quality prescriptions. Edelson et al. does not teach or suggest any additional structures which would enable a prescription order to be sent to a shipping facility so that a prescription drug is shipped from the shipping facility. Furthermore, Edelson et al. does not disclose an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities. This is because it was the inventors of the present invention that were the first to devise a system and appreciate the benefits of providing customers the convenience of placing a prescription order and having the order sent directly to their home, or any other convenient location, without ever having to leave their home or office.

Additionally, it is submitted that Edelson et al. does not disclose a system that includes a database containing personal information concerning one or more customers. Nor does Edelson disclose allowing one or more customers to access their personal information. While the system disclosed in Edelson assists physicians in prescribing and reviewing drugs, it does not disclose a database containing personal information concerning one or more customers. The examiner argues that in Edelson, "the professional using the system is capable of creating a prescription for him/herself." However, the examiner does not argue

that Edelson discloses allowing the doctor to access a database that contains personal information about the doctor, which would be necessary if Edelson were to anticipate the claimed elements of claim 1. Nor does such disclosure exist. Moreover, Edelson et al. only allows physicians to access the system to order prescription drugs for themselves. The Edelson et al. system does not allow a customer who is not a physician to transmit a prescription order, as the system recited in claim 1 does. For those who are not physicians, the difference is enormous.

Furthermore, the system for accessing pharmacy data and ordering prescriptions via the network as originally recited in amended claim 1 includes (1) a network server that is accessible by one or more customers, (2) a database that contains information concerning drugs and personal information concerning one or more of the customers, and (3) an application server that is configured to allow each of the one or more customers to access the information concerning drugs and personal information concerning each respective customer of the one or more customers and enable each of the one or more customers to one of transmit a prescription order to at least one of the plurality of member pharmacies and one of the one or more shipping facilities, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities. It is submitted that Edelson et al. appears to only disclose allowing access to the system by physicians and "other medical professionals, especially those having prescribing authority." (Col. 51, ll 41-42)

In fact, Edelson et al. distinguishes between customers and professionals by the following: "[i]n a more general sense, the invention provides a service professional with significant new benefits, especially during a service encounter with a customer or client, in selecting, specifying or providing technical remedies to consumer problems." (Col. 51, ll 44-47; *see also* Col 5, l 66 to Col. 6, l 8 and Col. 52, ll 18-29) Nowhere in Edelson et al. does it appear to disclose allowing the actual customer, as specifically distinguished from a physician by Edelson et al., to (1) access a network server, (2) access a database containing information concerning drugs and personal information of the customer, and (3) access an application server containing information concerning drugs and personal information concerning the customer and enable the customer to transmit a prescription order to either a member pharmacy or a shipping facility, or both.

Because no embodiment of Edelson et al. appears to disclose the invention recited in claim 1, it is submitted that claim 1 is not anticipated by Edelson et al. In order for a claim to be anticipated under § 102, the anticipating reference must disclose at least one embodiment that incorporates all of the claimed elements. *See for example, C.R. Bard, Inc. v. M3 Systems*, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998) ("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device..."); *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review...").

Therefore, the invention recited in independent claim 1 is not anticipated by Edelson et al. It is respectfully submitted that claim 1 and claims 2-8 which depend therefrom are allowable over Edelson et al.

Claims 9-16

Claim 9 is directed to a method of enabling one or more customers to order prescriptions and access pharmacy data via a network that includes registering a customer with a network website and displaying to the customer on the website at least one of a prescription order selection and a pharmacy data access selection. The method also includes allowing a customer to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities, and displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

For at least the reasons stated above with respect to claim 1, it is submitted that Edelson et al. does not disclose a method of allowing a customer to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities. Nor is such a concept inherent from the system disclosed in Edelson et al. Furthermore, Edelson et al. does not disclose a system that allows customers, as opposed to physicians ordering a prescription for

themselves, to access a personal prescription history and specific drug information from a database, as well as transmitting a prescription order.

Furthermore, the Examiner argues on page 5 of the final Office action that Edelson discloses at Col. 47, lines 1-7 a method of accessing a network server capable of hosting a network website via the network. However, this section identified by the Examiner only discloses a host facility that "can reach out ... across the INTERNET to multiple remote databases..." Applicants respectfully submit that accessing an unrelated, remote database across the Internet is substantially different from accessing a network server hosting a network website, where that particular website is used to register a customer, display a prescription order selection, and display a pharmacy data access selection. None of which are disclosed in Edelson et al.

In view of the foregoing, it is respectfully submitted that a proper *prima facie* case of anticipation has not been made in connection with claim 9 for at least the reasons noted above. Accordingly, it is submitted that claim 9, and claims 10-16 which depend therefrom, are in condition for allowance.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

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Respectfully submitted,

By 

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